

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT CATANEO
and RALPH CATANEO

Appeal No. 94-1549
Application 07/945,540¹

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and GRON, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 15. Claims 17 through 21 are pending but have been withdrawn from consideration by the examiner.

¹ Application for patent filed September 16, 1992. According to appellants, the application is a continuation-in-part of Application 07/528,348, filed May 22, 1990; which is a continuation of Application 07/226,953, filed August 1, 1988; and a continuation-in-part of Application 07/379,182, filed July 13, 1989, now abandoned; which is a continuation-in-part of Application 07/226,953, filed August 1, 1988.

Claims 1 and 2 are illustrative of the subject matter on appeal:

1. A nail polish remover consisting essentially of: (a) about 25 to 95% glycol ether ester; and (b) about 5 to 75% glycol ether.
2. The nail polish remover of claim 1 additionally comprising: (c) about 5 to 40% water.

The reference relied upon by the examiner is:

Durham	4,948,697	Aug. 14, 1990
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Claims 1 through 15 stand rejected under 35 U.S.C. § 103 as unpatentable over Durham. Claims 5 through 15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 2 through 15 stand rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

We affirm-in-part the prior art rejection, reverse the rejection under 35 U.S.C. § 112, second paragraph, and affirm the rejection under 35 U.S.C. § 112, fourth paragraph.

Prior Art Rejection

As seen from claim 1 on appeal, the claimed invention involves a nail polish remover which consists essentially of about 25-95% glycol ether ester and 5-75% glycol ether. That composition is further modified by claim 2 as “additionally

comprising” about 5-40% water. The remaining claims on appeal all depend directly or indirectly from claim 2.

Durham is directed to positive working photosensitive elements which are coated with a formulation containing a novolak or polyvinyl phenol resin, a diazide sensitizer, and a solvent mixture comprising propylene glycol alkyl ether and propylene glycol alkyl ether acetate. At column 1, lines 19-26, Durham indicates that prior art positive photoresist formulations were formed by dissolving the resin and diazide sensitizer in an organic solvent or mixture of solvents. This latter disclosure forms a reasonable basis to conclude that in this art, the final positive photoresist composition is formed using a separate source of the solvent mixture as a starting material. The examples of Durham set forth in column 7 form resist formulations from a novolak resin, a sensitizer, and a solvent mixture of propylene glycol alkyl ether and propylene glycol alkyl ether acetate in weight proportions encompassed by claim 1 on appeal.

Reading the exemplified formulations at column 7 of Durham in light of the prior art teaching referenced at column 1 of the reference that such formulations are conventionally formed by dissolving the resin and sensitizer in a preformed mixture of solvents, we hold that one of ordinary skill in the art would have found it prima facie obvious to form a mixture of propylene glycol alkyl ether and propylene glycol alkyl ether acetate having the weight ratios disclosed in the examples of Durham which will

subsequently be used to form the photoresist composition of Durham. The preformed solvent mixture meets the requirements of claim 1 on appeal. The statement of intended use set forth in claim 1 on appeal does not patentably distinguish the claimed composition from that reasonably suggested by Durham. In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Consequently we affirm the rejection of claim 1.

We reverse the rejection of claims 2-15. Claims 2-15 require, inter alia, that the claimed composition contain about 5-40% water. The examiner pointed to column 6, lines 44-54, of Durham at page 2 of the First Office Action (Paper No. 3, December 3, 1992) as teaching this aspect of the claimed invention. That portion of Durham is directed to developing the exposed, resist-coated substrates of that invention. As seen from that portion of the reference, the coated photoresist composition is subjected to an elevated temperature to remove a substantial portion of the solvent content. See column 6, lines 8-43, of Durham. As specifically set forth at column 6, lines 34-39, when the coated substrate is contacted with water, the photoresist coating contains, at most, about 30% solvent. The lowest amount of solvent which can be present in the composition of claim 2 on appeal is 60%. The examiner has not taken this discrepancy in solvent values into account in making his patentability determination under 35 U.S.C. § 103.

A second error in regard to the examiner's analysis of the patentability of claims 2-15 under 35 U.S.C. § 103 is that when the coated composition of Durham is contacted with water, it contains not only the solvent mixture but also the resin and sensitizer. Thus, the composition relied upon by the examiner to meet the requirements of claim 2 on appeal contains a solvent mixture, a resin, a sensitizer, and water. If claim 2 is properly put in independent form, it would be directed to a nail polish remover consisting essentially of the stated amounts of glycol ether ester, glycol ether, and water. As set forth in In re Janakirama-Rao, 317 F.2d 951, 954, 137 USPQ 893, 896 (CCPA 1963):

The word 'essentially' [in 'consisting essentially of'] opens the claims to the inclusion of ingredients which would not materially affect the basic and novel characteristics of appellant's compositions as defined in the balance of the claim.

The examiner has failed to explain on what basis one of ordinary skill in the art would consider the nail polish remover composition of claim 1 to be open to the inclusion of a resin and a sensitizer. Those compounds would appear to materially affect the basic and novel characteristics of the claimed nail polish remover composition.

In summary, we affirm the rejection under 35 U.S.C. § 103 as it pertains to claim 1 and reverse the rejection as it pertains to claims 2-15.

Rejection Under 35 U.S.C. § 112, Second Paragraph

As set forth at page 2 of the Final Office Action (Paper No. 5, May 13, 1993), the examiner rejects these claims on the basis “[t]he language ‘effective amount’ absent a [sic] indication of what it is effective for is indefinite.”

In our view, this rejection is based upon a misreading of claim 5. Claim 5 in relevant part requires “an effective amount up to about 15% co-solvent.” Obviously, the additive specified in this claim is to function as a co-solvent. As to what amounts would be suitable as the “effective amount,” we point to Table 1 of the specification which sets forth exemplary compositions which include co-solvents.

The rejection under 35 U.S.C. § 112, second paragraph, is reversed.

Rejection under 35 U.S.C. § 112, Fourth Paragraph

The basis for this rejection is that claim 1 on appeal uses the phrase “consisting essentially of” while the remaining claims use the phrase “comprising” or “comprises.” In the examiner’s view, it appears that appellants are attempting to modify the restrictive phrase “consisting essentially of” in claim 1 in the subsequent claims by the non-restrictive phrase “comprising.”

Appellants do not dispute the merits of this rejection. Rather, appellants argue at page 2 of the Reply Brief (Paper No. 11, filed January 10, 1994) that it was the intent

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of appellants that “claim 2 was to recite a remover ‘consisting essentially of’ ester, ether, and water.” While that may be appellants’ intention, we must take the claims as they appear before us on appeal. Accordingly, we affirm the rejection under 35 U.S.C. § 112, fourth paragraph.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Sherman D. Winters)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
William F. Smith)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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